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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,153	10/27/2006	Ralf Dunkel	CS-8779/BCS033006	2200

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EXAMINER
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SZNAIDMAN, MARCOS L

ART UNIT	PAPER NUMBER
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1628

NOTIFICATION DATE	DELIVERY MODE
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06/07/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

blair.wilson@bayer.com  
pamula.ramsey@bayer.com  
destiny.davenport@bayer.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,153	<b>Applicant(s)</b> DUNKEL ET AL.	
	<b>Examiner</b> MARCOS L. SZNAIDMAN	<b>Art Unit</b> 1628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4 pages / 10/28/10 and 04/11/11</u> .                         | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

This office action is in response to applicant's request for continued examination filed on January 26, 2010.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

#### ***Status of Claims***

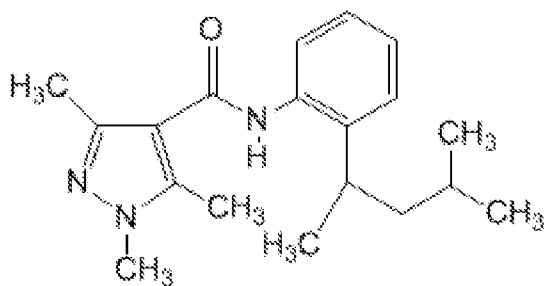
Amendment of claims 11-12 is acknowledged

Claims 11-14, and 17-18 are currently pending and are the subject of this office action.

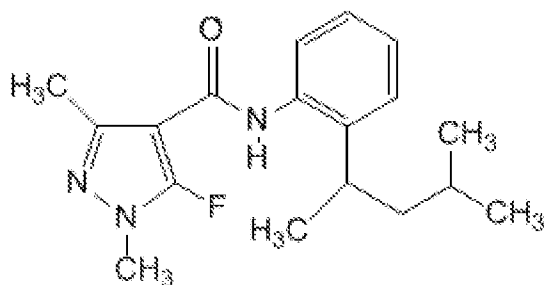
Claims 13-14 and 18 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2008.

Applicant elected the following species in the reply filed on 07/14/08:

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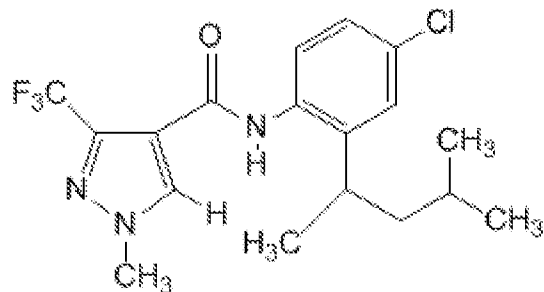
In the Office Action mailed on 10/29/08, the elected species was found free of prior art, so the examination was expanded to the following species: N-[2-(1,3-dimethylbutyl)phenyl]-5-fluoro-1,3-dimethyl-1H-pyrazole-4-carboxamide (CAS# 494793-67-8):



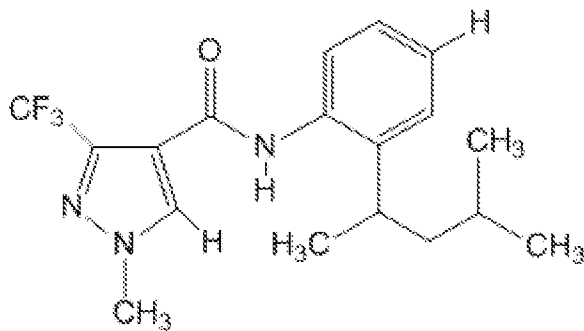
The same species was used in the Office Action mailed on 04/24/09.

Due to Applicant's amendment of the claims in the reply filed on 07/31/09, the above species no longer read on the instant claims. So the examination was expanded to the following species: N-[4-Chloro-2-(1,3-dimethylbutyl)phenyl]-1-methyl-3-(trifluoromethyl)-1H-pyrazole-4-carboxamide (CAS# 203448-85-5):

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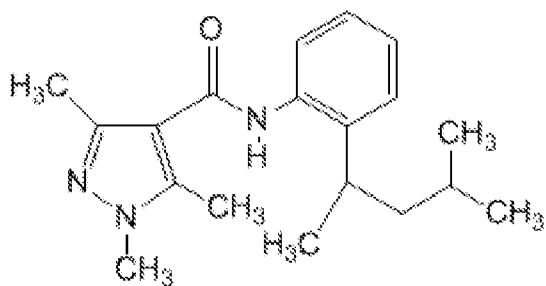


Due to Applicant's amendment of the claims in the reply filed on 01/26/10, the above species no longer reads on the instant claims. So the examination was expanded to the following species: N-[2-(1,3-dimethylbutyl)phenyl]-1-methyl-3-(trifluoromethyl)-1H-pyrazole-4-carboxamide (CAS# 203448-69-5):



In summary, the following species are under examination:

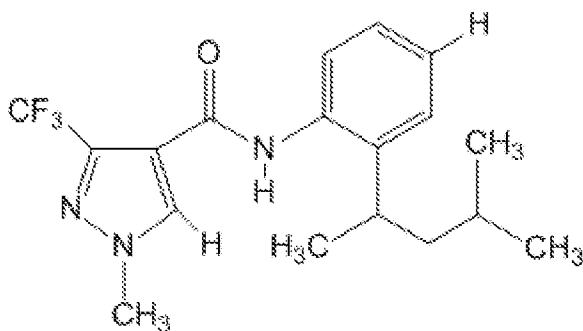
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elected by Applicant on 07/14/08, which is

free of prior art, and

N-[2-(1,3-dimethylbutyl)phenyl]-1-methyl-3-(trifluoromethyl)-1H-pyrazole-4-carboxamide (CAS# 203448-69-5):



The following claims read on one or both species and are under examination 11-12 and 17.

### ***Priority***

The present application is a 371 of PCT/EP04/11394 filed on 10/12/2004, and claims priority to foreign application GERMANY 10349502.9 filed on 10/23/2003.

### ***Rejections and/or Objections and Response to Arguments***

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Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated (Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

***Claim Rejections - 35 USC § 103(New Rejection)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

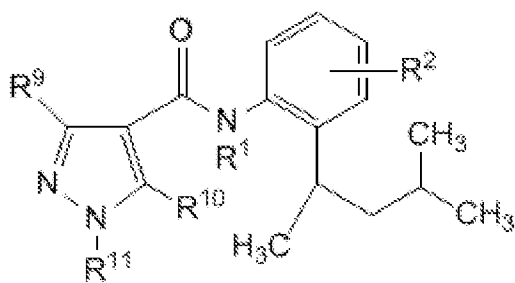
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

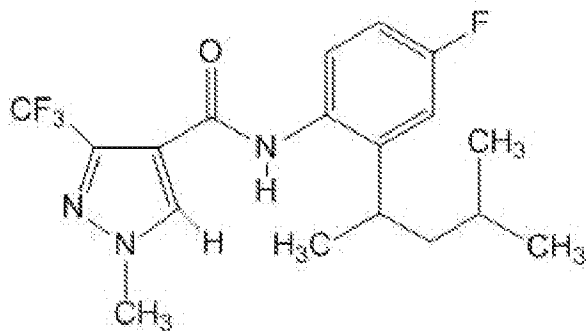
Claims 11-12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa (US 5,914,344, cited in previous office action) in view of Patani et. al. (Chem. Rev. (1996) 96:3147-3176).

Claims 11 and 12 recite a compound of general formula I:



which encompasses the following compound:

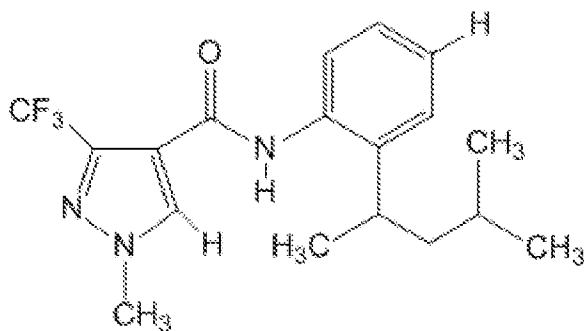
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(from now on Compound A, see also example 12 on page 41 of the specification)

For claims 11 and 12, Yoshikawa teaches the following compound:

N-[2-(1,3-dimethylbutyl)phenyl]-1-methyl-3-(trifluoromethyl)-1H-pyrazole-4-carboxamide (CAS# 203448-69-5):



(see column 17, lines 40-45,

Example 2, from now on Compound B), which differs from compound A, in that the aromatic ring is substituted with Hydrogen instead of Fluorine.

Patani teaches that the substitution of Hydrogen by Fluorine is one of the most commonly employed monovalent isosteric replacements (see page 3149, left column under 1. Fluorine vs. Hydrogen Replacements). Further in Figure 2 on the same page they give an example wherein replacing Hydrogen with Fluorine in an aromatic ring

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maintains or improves the pharmacological properties of the compounds. In summary, substituting Hydrogen by Fluorine is routine practice in the pharmaceutical art, and should not alter the biological/pharmaceutical properties.

Further, MPEP 2144.09, Section III states: prior art structures do not have to be true homologs or isomers to render structurally similar compounds *prima facie* obvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979) (Claimed and prior art compounds were both directed to heterocyclic carbamoyloximino compounds having pesticidal activity. The only structural difference between the claimed and prior art was that the ring structures of the claimed compounds had two carbon atoms between two sulfur atoms, whereas the prior art ring structures had either one or three carbon atoms between two sulfur atoms. The court held that although the prior art compounds were not true homologs or isomers of the claimed compounds, the similarity between the chemical structures and properties is sufficiently close that one of ordinary skill in the art would have been motivated to make the claimed compounds in searching for new pesticides). *In re Gyurik*, 201 USPQ 552, 596 F2d 1012 on page 557 states: “In obviousness rejections based on close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.” In this case it is expected, as discussed above, that compounds differing only by the presence or absence of Fluorine in the aromatic ring, would have similar chemical, physical and biochemical properties as discussed above.

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At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to replace any aromatic Hydrogen Compound B with a Fluorine in order to obtain compound A, and expect these compounds to have the same biological/pharmaceutical properties, since the prior art teaches replacing Hydrogen with Fluorine is routine practice in the pharmaceutical art (see Patani above) and will not alter significantly the chemical and biological properties of these molecules, thus resulting in the practice of claims 11-12 with a reasonable expectation of success.

Claim 17 further limits claim 11, wherein the compound of formula I is in a composition comprising one or more extenders and/or surfactants.

For claim 17, Yoshikawa further teaches that the compounds of the invention are plant disease control agents (see column 1, lines 8-13) which can be used in formulations that comprise adjuvants (i.e. surfactants) like the ones listed in column 16, lines 13-28 and other nonionic surface active agents.

### ***Withdrawn Rejections and/or Objections***

#### ***Claims rejected under 35 USC 102 (b)***

Due to applicant's amendment of claims 11 and 12, the previous examined species: N-[4-Chloro-2-(1,3-dimethylbutyl)phenyl]-1-methyl-3-(trifluoromethyl)-1H-pyrazole-4-carboxamide (CAS# 203448-85-5), does no longer anticipate the claims, so the rejection is now moot.

Rejection under 35 USC 102(b) is withdrawn.

### ***Conclusion***

No claims are allowed.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571 272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1628.  
April 29, 2011.